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PATENT APPLICATION
ATTORNEY DOCKET NO. 10006644-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jeffrey R. Oar; Gregory J. May

Confirmation No: 1271

Application No: 10/081,005

Examiner: Anand B. Patel

Filing Date: February 19, 2002

Group Art Unit: 2116

SUBJECT: POWER SAVING FEATURES FOR COMPUTING SYSTEMS

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s). Note. No more that five (5) pages may be provided.

Respectfully submitted,
Jeffrey R. Oar; Gregory J. May

By _____
Douglas L. Weller
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Reg. No. 30,506

Date: October 3, 2005

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I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: October 4, 2005

Typed Name: Douglas L. Weller

Signature: _____

PRE-APPEAL BRIEF REQUEST FOR REVIEW
REASONS

Claims 23 through 31 are pending.

Examiner has rejected claims 23 through 31 under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,785724 (Drainville) in view of USPN 6,317,831 (King).

Overview of Errors made by Examiner

Applicant believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there are claim limitations that are not taught or suggested by any of the cited references.

Further, Examiner has failed to provide an adequate suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Drainville in light of King.

Specific Examples of Examiner Errors

By way or example, Applicant discusses limitations in the independent claims 23 not disclosed or suggested by the cited art. Examiner has made similar errors in the rejection of the other independent claims. For specific discussion of these claims, see the Response to Office Action filed August 24, 2005, at pages 9 through 14.

Independent Claim 23:

Independent claim 23 sets out a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant. Examiner has cited the combination of Drainville and King as disclosing the features of claim 23. However, Examiner has failed to establish a *prima facie* case of obviousness for the claim 23 because there are claim limitations that are not taught or suggested by any of the cited references. Further, the

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Examiner has provided an inadequate motivation for combining the cited references.

Subject Matter in claim 23 not disclosed by Drainville:

1. Drainville does not disclose a portable computer.

Examiner has asserted that remote device 22 shown in Figure 1 of Drainville is a portable computer. However, nothing in Drainville discloses or suggests that this is so. In fact, Drainville teaches away from remote device 22 being a portable computer. Specifically, remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. It is clear from this teaching of Drainville that Drainville is not disclosing or suggesting that remote device 22 is a portable computer, but rather is specifically disclosing that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through a modem.

For fuller discussion on this issue see the Response to Office Action filed August 24, 2005, at pages 2 through 4.

2. Drainville does not disclose a personal digital assistant.

Examiner concedes that Drainville does not disclose a personal digital assistant.

3 Drainville does not disclose personal digital assistant waking a portable computer.

Drainville does not disclose a portable computer being awakened from a sleep mode in response to a wireless communication from a personal digital assistant. A response is generated and the response is transmitted via another wireless communication transmission.

Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not disclose or

suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 23, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital assistant. A response is generated and the response is transmitted via another wireless communication transmission.

This is not disclosed or suggested by Drainville. Particularly, Drainville teaches that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. Thus Drainville does not disclose or suggest transmission of responses from a portable computer via wireless communication transmission. Rather, Drainville teaches that on-demand web server 22 responds to requests via wired connections through a modem.

At column 6, lines 8 through 13, Drainville suggests that an application web server 46 within a tapping web server 30 can perform a "phone tap" of on-demand server 22. The phone tap can be delivered through a wireless cell phone.

Examiner's factual misunderstanding of how King could be combined with Drainville:

Examiner has argued that King discloses wireless communications from a personal digital assistant and could be used as a client in the system shown by Drainville. However, even if, as suggested by Examiner, a client in the system shown by Drainville were replaced by a personal digital assistant, this would not disclose the subject matter set out in claim 23.

Particularly, Drainville does not disclose or suggest client 10 is in wireless communication with on demand web server 22. It is tapping web server 30 that performs the phone tap. Substituting a personal digital assistant for client 10 would not disclose the subject matter set out in the claims as Drainville does not disclose or suggest client 10 being in wireless communication with any entity.

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For fuller discussion on this issue see the Response to Office Action filed August 24, 2005, at pages 4 through 5.

Motivation for Modifying Drainville by King:

Examiner has asserted that an advantage of the system taught by King is a quickly achieved secure connection (column 4, lines 61 through 66). Examiner has argued that it would have been obvious to one of ordinary skill in the art at the time of invention to modify Drainville by King. Motivation to combine is the ability to quickly create a secure connection.

The motivation offered by Examiner for modifying Drainville in light of King is insufficient and not really applicable to the situation of Drainville. Drainville does not disclose or suggest that client 10 performs any wireless communication. Therefore, there appears to be no motivation to replace client 10 with a personal digital assistant that has wireless security.

Further, Drainville discloses tapping web server 30 communicating with web server 22 using a phone tap. The phone companies go to great lengths to provide desired security levels to users, and there is nothing in Drainville or King that would suggest that the security scheme set out in King would provide any better security than is already available in phone systems, or even be applicable in a phone application. Nothing in Drainville or King would suggest the advantage (or the feasibility) of replacing web server 30 located within the wired network of corporate facility 34 with a PDA.
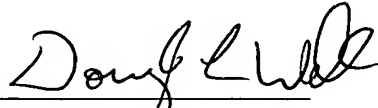
This error by Examiner is discussed the Response to Office Action filed August 24, 2005, at page 8.

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Conclusion

In light of the clear errors of fact made by the Examiner and failure of the Examiner to establish a *prima facie* case of obviousness for the claims, Applicant respectfully requests a withdrawal of the rejection.

Respectfully submitted,

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October 3, 2005